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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,925	02/09/2004	Kevin J. O'Neill	8082-4	5108

7590

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EXAMINER

CHIN, PETER

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/774,925

Applicant(s)

O'NEILL ET AL.

Examiner

Peter Chin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15, 16 and 18-22 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. The disclosure is objected to because of the following informalities: the term "sizing" is misspelled on page 7.

Appropriate correction is required.

2. Claim 22 is objected to because of the following informalities: The term "sizing" is misspelled. Appropriate correction is required.

3. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawing are crudely rendered such that there is difficulty ascertaining the details shown in the drawings. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

4. Claims 15-22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for charcoal, activated charcoal and activated carbon, does not reasonably provide enablement for carbon additives. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The term carbon additives reads on and includes carbon compounds and polymers, none of which are disclosed. Since there are literally millions of carbon compounds and polymers, one of ordinary skill in the art would not be able without undue experimentation to make and use the entire scope of the claimed invention.

5. Claims 15-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15: it is not clear if the each sheet of the plurality of paper sheets contain carbon additive.

If each sheet of paper contains carbon additive, the claim should recite -- a plurality of sheets of said paper --.

It is not clear whether one or all paper layers forming the linerboard contain the carbon additive. It is not clear whether the carbon additive is present in the inner or outer linerboard or both.

Additionally:

Claim 16: There is no connection established between the "linerboards" claimed and the boxboard claimed in claim 15 from which the claim depends from. Additionally it is not clear what the inner and outer linerboards are since there is no further structure to describe what they are "inner" and "outer" to, e.g., inner linerboard is the linerboard that when folded into a carton faces or in contact with the food?

Claim 17: there is no antecedent basis for "the inner linerboard".

Claims 19-22: the claims are incomplete since the nature or composition of the coating has been omitted.

6. Claim 15 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Howard (2,593,146) or Youngs et al (4,606,790)

Howard discloses paper or cardboard containing internally added activated carbon prior to sheet formation. Alternatively, the carbon may be applied to the outer layer or between layers of the paper or cardboard, see column 2. The paper or cardboard sheets are used to make containers for food, wherein one sheet or layer contains the activated carbon, see the first paragraph, column 3.

Thus, Leigh anticipates or obviously shows the claimed invention.

Youngs et al discloses a process for making corrugated carton or container board in which carbon powder. The carbon powder is internally added, i.e., to the aqueous pulp furnish prior to sheet formation. The carbon is present in the at least one of the layers of the multi ply liner of the paper board. The recitation that the container is for housing food is a statement of intended use of the container article and does not impart any patentable weight to the method of making the container. Thus, Youngs et al anticipates or obviously shows the claimed invention.

7. Claims 16, 18 and 20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Youngs et al (4,606,790).

Claims 16 and 18: Youngs discloses multiply liner and corrugated board.

Claim 20: The boards are made on a paper machine.

Thus, Youngs et al anticipates or obviously shows the claimed invention.

8. Claims 19, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Youngs et al (4,606,790).

Youngs et al discloses coating the liner board, column 5. The claimed coating methods are standard coating techniques in the art and are admitted as such by

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Applicant on page 7 of the specification. Thus, it would have been obvious means for applying a coating by any one of the claimed conventional coating means.

9. Claim 17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st and 2nd paragraphs, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. Applicant's election with traverse of the Group II invention in the reply filed on Nov. 8, 2004 is acknowledged. The traversal is on the ground(s) that there is no undue burden to search all the inventions. This is not found persuasive because no proper showing or evidence has been present to support the argument.

The requirement is still deemed proper and is therefore made FINAL.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Parks (5,693,385) discloses paper carton board coated with an absorbent layer of activated carbon. Coating is performed by conventional coating techniques: air knife, blade, wire wound rod, rotogravure. The carton is suitable for storing food. Note that this patent is **highly pertinent** to the disclosed embodiment in which the carbon is applied by coating the paper sheet or paper board.

Cavagna et al (5,153,061) discloses paperboard carton coated with a composition containing activated carbon adsorbent. **Cavagna et al is highly pertinent** as noted above.

Doying (3,091,550) discloses paper, sheets of paper and corrugated paper coated with an adsorbent layer containing activated carbon. Note that Doying teaches

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that it is well known to use activated carbon not only for odor adsorption but also for moisture adsorption. **Highly pertinent** as noted above.

Gary (2,417,924) discloses a desiccant paper having a coating of absorbent carbon.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Chin whose telephone number is (571) 272-1186. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Peter Chin', with a stylized, cursive script.

Peter Chin
Primary Examiner
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